Remarks

Claims 36-90 have been rejected under 35 U.S.C. § 251 as being an improper recapture of surrendered subject matter in the parent application. Particularly, the Office Action asserts that a broadening aspect is present in the reissue Independent Claims 36, 42, 49, 58, 59, and 76 that was not present in the application for patent, and that because the alleged surrendered subject matter relates to the alleged recaptured matter, the unduly narrow scope of the parent claims was not permissible error within the meaning of the reissue statute. Furthermore, the Office Action states that Applicant's reissue oath/declaration is defective because it fails to identify at least one error that is relied upon to support the reissue application.

Applicant respectfully maintains that the Office Action has mischaracterized and misapplied the holdings of the above cases as well as the current state of the recapture doctrine. Particularly, Applicant asserts: 1) the failure to appreciate the scope of the invention as embodied in the original and parent reissue claims is an acceptable error within the meaning of 35 U.S.C. § 251 and; 2) that because no admission as to the necessity of the limitation "virtual device driver" for patentability of the invention was made on the part of Applicant, the removal of this limitation is not barred by the recapture doctrine.

Failure to Appreciate the Scope of the Invention is Acceptable Error within the Meaning of 35 U.S.C. § 251

The Office Action cites § 1414(II) as basis for the assertion that the reissue oath/declaration is defective for failure to identify at least one error that is relied upon to

support the reissue application. Specifically, the Office Action states that the general statement that the claims are too narrow because the attorney failed to appreciate the full scope of the invention does not constitute permissible error within the meaning of 37 CFR § 1.175.

MPEP § 1414(II) states in relevant part:

> "A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective" (MPEP § 1414(II), 1st paragraph, Pg. 1400-22)

Later, in the same paragraph as the above passage, the MPEP states:

> "See MPEP §1402 for a discussion of grounds for filing a reissue that may constitute "error" required by 35 U.S.C. § 251." (MPEP §1414(II), 1st paragraph, Pg. 1400-22)

Finally, MPEP § 1402 states:

> "An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in In re Wilder, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984)." (MPEP § 1402, 5th paragraph, Pg. 1400-2)

Applicant stated in his response to the Office Action mailed 4/02/02 that the grounds for the reissue application rest, at least in part, upon the attorney's failure to appreciate the scope of the invention resulting in the claims as originally filed in the parent case being too narrow. In other words, Applicant has stated, and restates in the present Amendment, that the "specific error" requested in the present Office Action is the unduly narrow claims of the parent Application resulting from the attorney failing to appreciate the scope of the invention. Furthermore, as indicated above, both the Federal Circuit and the MPEP consider such an error to be permissible grounds for filing a reissue application.

Applicant has submitted reissue claims 36-90 for examination after realizing his attorney's failure to appreciate the full scope of the invention as embodied in the original and parent reissue claims. Furthermore, this much is declared in the accompanying oath/declaration as requested in the Office Action. Therefore, Applicant has fulfilled his obligation under 35 U.S.C. § 251 for asserting an error upon that makes the original application wholly or impartially invalid as required under 37 CFR § 1.175(a)(1).

The Recapture Doctrine Does not Preclude Applicant's Reissue Claims, Because they are Narrower than the Original Claims

The Office Action essentially asserts that Applicant's reissue claims are precluded by the recapture doctrine, because applicant is seeking to remove a material limitation in the reissue claims without limiting the reissue claims in a manner materially related to the removed limitation. Furthermore, the Office Action asserts that the added narrower limitations must relate to the removed limitation because Applicant relied upon it to overcome prior art in the parent case. Specifically, the Office Action asserts that the removal of "virtual device driver" from the reissue claims is impermissible recapture, because the limitation was added to overcome prior art in the parent case and therefore the reissue claims must be narrowed in a manner materially related to the removed limitation.

A recent Precedential Opinion by the Board of Patent Appeals and Interference, however, has held that reissue claims are not necessarily precluded by the recapture doctrine if they are narrower than the original claims, even though a limitation is

removed in the reissue claims that the Applicant relied upon to overcome prior art in the parent application. See Ex parte Danial M. Eggert and Frank Mikic, Decided May 29, 2003 (hereafter "Eggert").

Applicant has stated, and the Office Action appears to agree, that the reissue claims are narrower in scope in at least some aspects than the original claims of the parent application. The Office Action asserts, however, that the manner in which the reissue claims are narrowed is not substantially related to the removed limitation, "virtual device driver". The Office Action further asserts that it is necessary for the added limitations in the reissue claims to be substantially related to the removed limitation, "virtual device driver", because the latter term was added to overcome prior art in the original application.

Under Eggert, however, an Applicant's alleged reliance upon a limitation to overcome prior art is not a per se adequate basis for precluding reissue claims that are narrower than the original claims of the parent application. The added limitations of the reissue claims, including the power management module and instruction limitations, which include measuring the amount of time the processor has its clock stopped and the reduction of the voltage level applied to the processor accordingly, are themselves narrower than the limitations of the original claims. Furthermore, the Office Action appears to discount these limitations merely because they are allegedly unrelated to the removed limitation, "virtual device driver". Under Eggert, the Office Action may not, however, properly preclude the Applicant's claims under the recapture doctrine merely because they do not relate to a limitation allegedly relied upon for patentability in the original application.

Additionally, the Examiner is advised that the parent application, P2319R, which was rejected under the recapture doctrine for similar reasons as the present case, has recently been remanded from the Board of Patent Appeals and Interferences to the Examiner for further consideration in view of Eggert.

Conclusion

Because the Applicant has committed a permissible error within the meaning of 35 U.S.C. § 251, namely, attorney's failure to appreciate the scope of the invention as embodied in the original and parent reissue claims, the removal of the limitation, "virtual device driver", is not barred under the statute.

Furthermore, in view of the recent Precedential Opinion, Eggert, the Office Action may not reject Applicant's reissue claims under the recapture doctrine merely because a limitation was removed that is alleged to have been relied upon by the Applicant in the prosecution of the original application, and the reissue claims include limitations that allegedly are not substantially related to the removed limitation.

Finally, because Applicant's reissue claims are narrower than the original claims in the parent application, the reissue claims escape the application of recapture doctrine and should therefore be allowed under 35 U.S.C. § 251 in view of Eggert.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,

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